



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
2001	2001-10-10	AN	2001-5-1016-00

11/17/00
C. R. SMITH AND REYNOLDS, P.C.
WASHINGTON, DC
2000-10-10

EXAMINER

WILDER, C

ART UNIT	PAPER NUMBER
2001	5

DATE MAILED:

12/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/536,841

Applicant(s)

FAN et al.

Examiner

CB Wilder

Group Art Unit
1655



☒ Responsive to communication(s) filed on Oct 5, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-40 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1655

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, 20-25, drawn to oligonucleotide array and kit, classified in class 536, subclass 24.3 and class 435, subclass 810..
 - II. Claim 3, drawn to a method of genotyping nucleic acid, classified in class 435, subclass 6.
 - III. Claims 4-19, 26-40, drawn to drawn to a primer extension method for determining ration of alleles at polymorphic sites, classified in class 435, subclass 91.1
2. The inventions are distinct, each from the other because of the following reasons: ~~Inventions~~ I and II, III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the array and reagents of the kit can be used in a materially different process such as in automated system for manipulating and sorting polynucleotides.
3. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different

Art Unit: 1655

methods require the use of different reagents, involved in different method steps and/or have different objectives. Invention II requires the use of locus-specific tagged oligonucleotides in a hybridization assay for the objective of genotyping a nucleic acid sample. Invention III requires the use of primer pairs in an amplification reaction for the objective of determining the ration of alleles at a polymorphic site. The different inventions are novel and patentably distinct.

4. Because these inventions are distinct for the reasons given above and the search required for any one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Ms. Lisa Treannie on December 6, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made. Ms. Treannie request a written restriction be made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

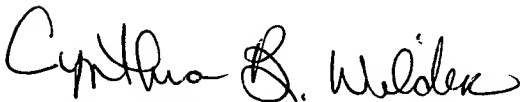
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Art Unit: 1655


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cynthia Wilder whose telephone number is (703) 305-1680. The examiner can normally be reached on Monday through Thursday from 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152. The official fax phone number for the Group is (703) 308-4242. The unofficial fax number is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed the Group's receptionist whose telephone number is (703) 308-0196.


Cynthia B. Wilder, Ph.D.

December 15, 2000


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600

12/15/00